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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,778	09/05/2003	Adolf Stender	64251-022CIP	8988

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HUSCH & EPPENBERGER, LLC
401 MAIN STREET
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PEORIA, IL 61602

EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,778

Applicant(s)

STENDER ET AL

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. .
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The rejections based on 35 USC 103 have been altered to reflect the amended claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant relies on an incorporation by reference for support of the amended language. However, it is not evident that the applicant intended to incorporate the reference into the disclosure of the application, especially since the language "incorporated by reference" is nowhere in the specification. Thus, the newly added language is new matter.

Specification

4. The amendment filed 10 August 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amended

language regarding the crosslinked polyurethane gels, which the applicant claims is supported by an incorporation by reference.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgdörfer et al. in view of Downey et al. as evidenced by Withers.
7. Burgdörfer discloses polyurethane elastic gels for padding elements comprising a crosslinked polyurethane matrix, a polyhydroxy liquid dispersing agent, and optional fillers or additives (abstract). Since the reference discusses that some of the polymer chains are covalently crosslinked, while others are bonded mechanically, it is the examiner's position that the reference teaches undercured reaction products of polyols and polyisocyanates (col. 4 lines 27-39). The dispersing agent is partially bonded to the polyurethane gel matrix while still possessing reactive groups. Polyisocyanates include aliphatic, cycloaliphatic, araliphatic, and aromatic polyisocyanates fitting the applicant's formula (col. 7 lines 15-33). Pure and modified isocyanates, urethanised isocyanates, allophanised isocyanates, and biuretised isocyanates are all taught (col. 7 line 54-col. 8 line 38). Polyols include those having molecular weights of 1000-12,000 having OH numbers between 20 and 112 (col. 3 lines 18-39). The polyurethane is formed at an

isocyanate index of 15-60, with the product of isocyanate functionality to polyol functionality of at least 10 (col. 3 lines 27-59).

8. The reference teaches the inclusion of fillers or additives in amounts up to 50% by weight, noting that fillers and additives to be used are those conventional in polyurethane chemistry (col. 9 lines 28-30; col. 10 lines 46-48). However, the reference does not specify the use of elastic microspheres. Downey teaches polymer compositions, where fillers are incorporated into polyurethanes in a liquid or gel state to reduce the density of the composition (abstract; col. 4 lines 8-17). Dualite M6001AE spheres are taught and exemplified (col. 5 line 9; examples), where Withers has disclosed the materials as hollow expanded polyolefinic polyvinylidene chloride copolymers coated in calcium carbonate and having a mean particle size of 50 microns. Because the compositions include agents to prevent separation of the spheres from the matrix material and because the references both teach homogeneously mixing fillers, it is the examiner's position that the references suggest distributing the fillers to the exclusion of air bubbles. It is the examiner's position that it would have been prima facie obvious to include the expanded elastic spheres of the Downey invention in the gel materials of Burgdörfer to help reduce the density of the materials. Such a material would possess the applicant's claimed hardness and elasticity properties.

9. Regarding claim 12, Burgdörfer teaches combinations of polyols (examples) and teaches that polyols should have OH values of 20-112. However, the reference does not appear to exemplify the combination of a polyol having an OH value below 112 with one having an OH value of 112-600. It is the examiner's position that it would have

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been prima facie obvious to combine a polyol having an OH value below 112 with one having an OH value of 112 in any ratio necessary with the expectancy of forming equally improved polyurethane cushioning gels.

10. Regarding the newly added claims, it is noted that Burgdörfer discloses molded gel articles having polyurethane film cover layers (col. 12 lines 15-51; col. 13 lines 21-34).

Response to Arguments

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

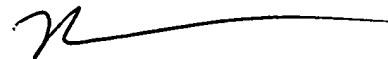
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie D. Bissett
Primary Examiner
Art Unit 1711

mdb